



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,865	01/29/2001	Michael Waters	70702	7798

22242 7590 03/24/2004

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,865

Applicant(s)

WATERS, MICHAEL

Examiner

Jan Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on January 29, 2001. Claims 1-11 are currently pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "the fields" in line 8. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 1 recites the limitation "the preselected information" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 1 recites the limitation "the preselected one" in in line 11. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 1 recites the limitation "the developed forms" in line 12. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 1 recites the limitation "the applications" in line 12-13. There is insufficient antecedent basis for this limitation in the claim.
7. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 1 is considered to have run on phrases with little punctuation which makes it difficult to understand the applicant's invention. Claims 2-11 read on claim 1.
9. What does the term "including" identify in line 4.

10. What does the term "thereof" identify in line 13.
11. The applicant cannot claim the expert review boards as part of the invention since you cannot get a patent on individual people.
12. What does the applicant mean by the communication path is electronically encrypted?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al (US 6,298,327) (hereinafter referred to as Hunter) in view of Risen et al. (US 6,018,714) (hereinafter referred to as Risen).

Referring to Claim 1:

Hunter discloses a system for developing commercially valuable intellectual property rights, comprising:

A communication path for allowing independent sources to send information packets to predetermined host (Figs. 1-3);

A host having expert review boards associated with a specific field of endeavor for developing information into commercially valuable form (Fig. 3 (51) Patentability assessments, (53) Marketability assessments, (55) Experts;

A structured database for receiving information (Fig.2).

Hunter does not disclose the information received being review by potential purchasers or licensors to generate maximized revenue. However, Risen discloses the information received being review by potential purchasers or licensors to generate maximized revenue (Fig. 1, (12-18)), Fig. 2)

It would have been obvious to one of ordinary skill in the art to incorporate into the system of Hunter the teachings of Risen since the seller and purchaser of a business usually conduct a “due diligence” analysis to determine a value for a portfolio of intellectual property to be sold and purchased and because an extensive analysis of intellectual property involves both legal and business value analysis.

As for Claim 2 and 6:

The Examiner takes Official Notice that web pages are old and well known in any system that operates over a network. Examples are the PTO websites. Preapproved access is also old and well known since access is only granted to parties that need access to the information while excluding parties that to not need to have access to the information. Examples of preapproved access is the ability to logon to certain websites here at the PTO. It is also old and well known to have communication paths established over an internet of linked computers since often many different entities are involved in the process and the parties from the entity need access to the information and need to be able to communicate with each other.

As for Claim 3:

The Examiner takes Official Notice that WAN and Intranet systems are old and well known in systems that allow inter communication between parties within a company (Intranet)

and parties outside the company. An example of this is the PTO website which has the Intranet for PTO employees to access and the Internet.

As for Claim 4:

Hunter discloses a system wherein the received information includes innovations (col. 2, lines 43-50).

As for Claim 5:

The Examiner takes Official Notice that it is old and well known to have the communication path electronically encrypted to prevent hackers.

As for Claim 7:

Hunter discloses a system wherein one of the experts is legal (col. 2, lines 43-50).

As for Claim 8:

It takes Official Notice that it is old and well have restricted access protocols to allow for preapproved entities to purchase or license desired patents. Examples of preapproval are buying a home, a car or various other credit.

As for Claim 9:

Hunter a screening board (Fig. 3 – Experts, patentability assessment, marketability assessment – an accessment is a screening)

As for Claim 10:

Hunter discloses a system wherein the predetermined factors include markets, status of competitive activity and patentability. (Fig. 3 Marketability and Patentability).

As for Claim 11:

Art Unit: 3629

Hunter discloses a second communication path and a second database (Figs. 2 and 3
Experts is plural and thus multiple parties).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eastman Chemical Company discloses a computer based system that manages intellectual property related documents and automated processed for securing intellectual property rights in a business enterprise.

Business Technology is that the biggest problem with technology is construing a value.

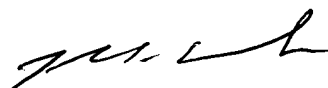
Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600